

Remarks

Applicant respectfully requests reconsideration of the pending claims as follows:

The provisional double patenting rejections:

Applicants note the provisional double patenting rejections and will submit corresponding terminal disclaimers upon the indication of allowable subject matter.

The rejection of claims 1-8 as being indefinite:

To clarify that "range offset in chips" has a well-known and definite meaning in the GPS arts, Applicant refers the Examiner to U.S. Pat. No. 7,142,589, assigned to Nokia. As discussed in that patent on Col. 4, lines 61 through Col. 5, line 20, every GPS satellite transmits a unique Gold code sequence that repeats a 1,023 bit sequence. To clarify that the Gold codes are not being used as data messages, the bits are referred to as "chips." (see, in particular, Col. 5, lines 10-12).

The GPS satellite transmissions are associated with a very accurate clock. So it is known when a satellite transmits its code sequence. What is unknown is the delay between the transmission time by the satellite and the receipt by the GPS receiver. Thus, as shown for example in Figures 2A and 2B of the Nokia patent, a GPS receiver correlates an internally-generated version of the Gold code sequence with the received Gold code sequence. The delay is measured with regard to the "chips" as shown in Figures 2A and 2B of the Nokia patent. This delay is also known as the code phase offset from the transmission time. Thus, is it is definite and well-known to those of ordinary skill in the GPS arts what is meant by "range offset in chips" as set forth in claim 1: that is referring to the delay in chips from the transmission time until the receipt time by the GPS receiver. Accordingly, claim 1 is definite to those of ordinary skill in the GPS arts.

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The rejection of claims 1-8 for failing to comply with the written description requirement

Applicant respectfully traverses this rejection as the Applicant is not required to limit his claims to a preferred embodiment. In that regard, Applicant did not state in the specification that "fixed point" correlation sums were an essential feature of the claimed invention. For example, consider the paragraph in the specification on page 9, lines 19-23 where Applicant states that

The correlator 54 receives the carrier frequency from the PLL/VCO 40 and prepositioning information from the microcontroller 60. The correlator 54 performs correlation functions on GPS signals received by the antenna 28 and processed by the GPS RF/IF 58 and ADC 56. Correlation sums are provided to the microcontroller 60 and forwarded to the RF transceiver 52 for transmission, as a correlation snapshot, to the interrogator 12.

Such a description is generic to the exact nature of the correlation sums. Applicant respectfully observes that the specification thus in no way has set forth any statements to the effect of "as used herein, correlations must always be fixed point correlation sums to be within the scope of the claimed invention." Instead, Applicant has described the correlations in a generic and non-limiting manner as set forth above. Accordingly, claim 1 as previously amended does not introduce any new matter.

As to the rejection of claim 5 for allegedly introducing new matter by amending "passive standby circuit" to "standby circuit," Applicant again notes that there are no statements in the specification to the effect that the "passive" title to the standby circuit was an essential feature of the claimed invention. For example, as set forth in the specification on page 8, lines 3-7, the transponders have a standby mode of operation. This mode is not described as a "passive" standby mode. Those of ordinary skill in the art will appreciate that, in order to enable a standby mode, some sort of standby circuit is necessary to stay awake during the standby mode so that the transponder may awake and resume normal operation. This circuit is claimed as a "standby circuit" in claim 5 and such usage is not new matter.

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In that regard, if a patent applicant discloses a vehicle having disc brakes, they will typically claim "brake" in their broadest independent claims because although the applicant disclosed disc brakes, one of ordinary skill in the art will appreciate that other types of brakes (such as drum brakes) may also be used. In that regard, if the rule of law were as proposed in the March 21, 2007 office action, patent scope would be very different since the claims would be limited to only the disclosed embodiments despite the presence of art-appreciated equivalents. However, that is not the law (and thankfully so for sake of the patent system) and thus claims 1-8 do not introduce new matter.

The rejection of claims 1-3 and 8 as being anticipated by Krasner (USP 5,781,156):

The Krasner reference does not disclose the transmission of a range offset in chips by the base station (element 10 in Figure 1A) to its mobile units. Indeed such a transmission would not be possible because Krasner discloses that the mobile units may be up to 150 km away from the mobile units. (Col. 5, lines 1-4). If a mobile unit can be anywhere from adjacent to up to 150 km away, how could a Krasner basestation know the range offset to send to the mobile units? In contrast, the claimed interrogator knows the approximate range to the interrogated transponders and thus can broadcast a range offset in chips to these transponders. Accordingly, none of the pending claims are anticipated by Krasner.

The remarks on page 7 of the March 21, 2007 office action:

Applicant respectfully notes some confusion regarding the observations beginning in the 3<sup>rd</sup> paragraph of page 7 of the March 21, 2007 office action in that it was not clear whether an actual rejection or objection was being made to the claims. Applicants will thus assume that a proposed rejection of claims 1-8 is being discussed on the grounds that these claims include functional limitations. In that regard, Applicants respectfully note that it is perfectly acceptable to claim a device with functional rather than structural limitations. In particular, MPEP § 2173.05(g) defines a functional limitation as "an attempt to define something by

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what it does, rather than what it is (e.g., as evidenced by its specific structure or specific ingredients). MPEP § 2173.05(g) then observes that there “is nothing inherently wrong with defining some part of an invention in functional terms.” Further, MPEP § 2173.05(g) quotes with approval the claim limitations of “members adapted to be positioned” and “portions ... being resiliently dilatable whereby said housing may be slidably positioned.” Applicant notes that the citation from MPEP § 2114 has to do with an intended use. For example, suppose the Applicant claims “a spoon, such as is found in any kitchen, wherein it is intended for use in Applicant’s home on July 23, 2007.” Although such a spoon is unique in that no other spoons but the Applicant’s are intended for such use, there is nothing structurally different about them so they are not patentable. But the limitations in claim 1 are not merely statements of intended use but are instead conventional and well-accepted functional limitations. There must be structural differences to support these functional limitations and thus Applicant’s claims are statutory. In that regard, the Examiner is encouraged to search on the terms “adapted to” [do some functional result] or “operable to” [do some functional result] to see the hundreds of thousands of U.S. Patents that use functional limitations because such usage is condoned by the MPEP and the courts.

In addition, the specification has been amended to be consistent with the drawings.

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CONCLUSION

For the above reasons, all pending claims are believed allowable. Their allowance is therefore requested. If the Examiner has any question regarding the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant at (408)-392-9250.

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Respectfully submitted,

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